



UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Application of Roderick L. Hall et al. :
Serial No.: 09/441,966 :
Filed: November 17, 1999 : PETITION DECISION
Attorney Docket No.: 98.736-A :

This is in response to applicants' petition, filed October 2, 2002 under 37 CFR 1.144, requesting withdrawal of the restriction requirement set forth by the examiner.

BACKGROUND

A review of the file history shows that this application was filed under 35 U.S.C. 111(b) on November 17, 1999 as a continuation-in-part of application 09/218,913, filed December 22, 1998. The application, as filed, contained claims 1-18. On April 2, 2002, the examiner mailed a restriction requirement dividing the claims into 16 groups, each group drawn to a method of treatment using a different protein. In the response filed April 15, 2002, applicants elected Group XVI, claims 1-10 and 15-18, as drawn to methods using SEQ ID NO: 8. Applicants traversed the restriction on the ground that each invention is classified in the same class and subclass. On July 2, 2002 the examiner mailed a first action on the merits. The examiner made the restriction final, noting that each sequence requires a different search.

DISCUSSION

Applicants present two lines of argument in the petition. First, applicants argue that the claimed sequences are all classified in the same class and subclass. This argument is not persuasive. MPEP 808.02 states, in part:

Where the related inventions as claimed are shown to be distinct under the criteria of MPEP § 806.05(c) - § 806.05(i), the examiner, in order to establish reasons for insisting upon restriction, must show by appropriate explanation one of the following:

(C) A different field of search : Where it is necessary to search for one of the distinct subjects in places where no pertinent art to the other subject exists, a different field of search is shown, even though the two are classified together.

Applicants are advised that a search of the available sequence databases produces a listing of

references disclosing the sequences most similar to the query sequence. This is the "place" where the examiner searches for prior art. The prior art relating to another query sequence will not be found in this "place" - a different listing of references must be generated and searched by the examiner. Thus a different field of search is shown, and restriction is proper.

Applicants argue that the claimed sequences are identical over portions of their length, and that a search of these portions would uncover any available prior art for all of the sequences. A sequence alignment is attached to the petition to illustrate applicants' position. This argument is not persuasive. In the case of fragments sharing a common sequence, it is true that if the common sequence is free of the prior art, then the longer sequences should also be free of the prior art (if "open" claim language is used). However, if the common fragment is not free of the prior art, then each of the longer sequences must also be searched. Of course, the outcome of the search can not be predicted.

Applicants' argument is not without merit. However, Applicants did not elect the shortest common sequence for examination, nor did they present the sequence alignment to the examiner at the time of election. Consequently a longer sequence has been searched and applicants have already received an Office action on the merits. Since restriction is discretionary, the examiner may have agreed to consider more sequences had the evidence presented with the petition been available, and the shortest sequence elected. But since the examiner did nothing improper, he will not be required to begin the examination process anew.

DECISION

Applicants's petition is **DENIED** for the reasons set forth above.

The application will be forwarded to the examiner for consideration of the amendment and response filed October 2, 2002.

Any request for reconsideration or review of this decision must be made by a renewed petition and must be filed within TWO MONTHS of the mailing date of this decision in order to be considered timely.

Should there be any questions with regard to this letter please contact Bruce Campell by letter addressed to the Director, Technology Center 1600, Washington, DC 20231, or by telephone at (703) 308-4205 or by facsimile transmission at (703) 746-5006.



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